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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,234	09/07/2000	James Patrick Allen	ROC9-2000-0220-US1	1600

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Joan Pennington
535 North Michigan Avenue
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EXAMINER

ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 04/08/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/657,234

Applicant(s)

ALLEN ET AL.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1 – 18 are presented for examination.

Claim Objections

1. Claim 16 is objected to because of the following informalities: Claim 16 references itself and is therefore has an improper claim dependency. Appropriate correction is required.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: ~~Hardware 120 is not referenced correctly in the~~ specification. On page 4, line 26 of the application, element 120 is referred to as “firmware”. This occurrence is frequently found in the application. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pass through by said device driver through a host bus adapter (HBA) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation of, "pass through by said device driver through a host bus adapter (HBA)," is not specifically found in the specification. In the specification the device driver is in a HBA.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4, 5, 14 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "common" in common transport or common services layer is too ambiguous as to what specifically is designated as "common".

9. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "standard" in standard HBA device driver interface is too ambiguous as to what specifically is designated as "standard".

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10. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "upper" in upper level protocol or upper layers does not specifically designate which part of the layered system is "upper" and is therefore ambiguous as to what specifically is "upper".

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1 – 3, 6, 7, 10 and 11 – 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Wieland U.S. Patent No. 6643748.

13. Referencing claim 1, as closely interpreted by the Examiner, Wieland teaches a storage area network (SAN) management and configuration method via enabling in-band communications comprising the steps of:

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14. utilizing a SAN management application for communicating with a device driver, (e.g. col. 6, line 33 – col. 7, line 3), and

15. providing a pass through by said device driver through a host bus adapter (HBA) for passing communications to a device in the storage area network from said SAN management application, (e.g. col. 5, lines 14 – 48).

16. Referencing claim 2, as closely interpreted by the Examiner, Wieland teaches the step of utilizing said SAN management application for communicating with a device driver includes the step of providing a management application agent coupled between said SAN management application and said device driver, (e.g. col. 6, line 58 – col. 7, line 32).

17. Referencing claim 3, as closely interpreted by the Examiner, Wieland teaches the step of utilizing said management application agent for providing predefined, fibre channel standard, protocol functions for communicating with said device in the storage area network, (e.g. col. 1, line 40 – col. 2, line 16).

18. Referencing claim 6, as closely interpreted by the Examiner, Wieland teaches the step of providing said pass through by said device driver through a host bus adapter (HBA) for passing communications to a device in the storage area network from said SAN management application includes the step of providing said pass through for passing a plurality of commands, (e.g. col. 6, line 53 – col. 7, line 32).

19. Referencing claim 7, as closely interpreted by the Examiner, Wieland teaches the step of providing said pass through for passing at least one topology analysis command, (e.g. col. 4, line 63 – col. 5, line 49 & col. 6, line 53 – col. 7, line 32).

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20. Referencing claim 10, as closely interpreted by the Examiner, Wieland teaches the step of providing said pass through for passing at least one configuration command, (e.g. col. 4, line 63 – col. 5, line 49 & col. 6, line 53 – col. 7, line 32).

21. Claims 11 – 14 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

~~(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.~~

23. Claims 4, 5, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wieland (6643748) in view of Stai et al. (6401128) (hereinafter Stai).

24. As per claim 4, as closely interpreted by the Examiner, Wieland teaches as the step of providing predefined protocol functions for communicating with said device in the storage area network include the step of providing a common transport (CT) protocol function, (e.g. col. 1, line 40 – col. 2, line 16), but does not teach an extended link service (ELS) protocol function. Stai teaches an extended link service (ELS) protocol function, (e.g. col. 6, line 33 – col. 7, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Stai with Wieland because it would be more efficient for a system to utilize ELS for responding to a payload translation during a public-to-private translation or private-to-public.

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25. As per claim 5, as closely interpreted by the Examiner, Wieland teaches the step of providing a pass through by said device driver through a host bus adapter (HBA) includes the step of providing a common transport (CT) pass through and by said device driver through said host bus adapter (HBA), (e.g. col. 1, line 40 – col. 2, line 16) but does not specifically teach an extended link service (ELS) pass through. Stai teaches an extended link service (ELS) pass through, (e.g. col. 6, line 33 – col. 7, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Stai with Wieland because of similar reasons stated above.

26. Claims 17 and 18 are rejected for similar reasons stated above.

~~27. Claims 8, 9, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wieland (6643748) in view of Panas et al. (6473857) (hereinafter Panas).~~

28. As per claim 8, as closely interpreted by the Examiner, Wieland does not specifically teach the step of providing said pass through for passing at least one performance analysis command. Panas teaches the step of providing said pass through for passing at least one performance analysis command, (e.g. col. 4, lines 36 – 61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Panas with Wieland because it would be more efficient for a system to analyze the performance of a system in order to make sure that the system is running properly and when errors occur, they are easily identified and taken care of.

29. As per claim 9, as closely interpreted by the Examiner, Wieland does not specifically teach the step of providing said pass through for passing at least one attribute analysis command. Panas teaches the step of providing said pass through for passing at least one attribute analysis command, (e.g. col. 4, lines 36 – 61). It

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would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Panas with Wieland because it would be more efficient for a system to analyze the attribute to see if there are trends in the system that could lead to a efficient running system or a system with errors in it.

30. Claims 16 and 17 are rejected for similar reasons as stated above.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

32. a. Latif et al. U.S. Patent No. 6400730 discloses Method and apparatus for transferring data between IP network devices and SCSI and fibre channel devices over an IP network.

33. b. Blumeau et al. U.S. Patent No. 6665714 discloses Method and apparatus for determining an identity of a network device.

34. c. Kelman U.S. Patent No. 6671820 discloses System and method for the prevention of corruption of networked storage devices during backup data recovery.

35. d. Allen et al. U.S. Patent No. 6643586 discloses System and method to determine fibre channel device locations using GPS.

36. e. O'Connor U.S. Patent No. 6584582 discloses Method of file system recovery logging.

37. f. Blades et al. U.S. Patent No. 6493811 discloses Intelligent controller accessed through addressable virtual space.

38. g. Schubert et al. U.S. Patent No. 6460113 discloses System and method for performing backup operations using a fibre channel fabric in a multi-computer environment.

39. h. Aziz et al. U.S. Patent No. 6597956 discloses Method and apparatus for controlling an extensible computing system.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

De *DL*


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